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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,975	10/10/2002	Melanie Ann Pykett	025069-00001	9572

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,975

Applicant(s)

PYKETT ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/11/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 20, 2004 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6524626 B2) in view of Mathur et al. (US 6326202 B1).**

Chen teaches topical compositions comprising ginseng (Panax Ginseng) berry juice and extracts combined with other skin nutrients to provide essential vitamins and nutrients in a natural way. See abstract. Example 22 discloses a composition comprising 4% of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 4, 6, 9, 13, 14, 20, 26, and 27, which contains at least three antioxidants recited in claim 1 wherein the total amount of the antioxidants exceed 5 % by weight of the total composition.

While the total amount of the antioxidants in Example 22 exceeds the recited 3.5 % in the instant claims, examiner notes that differences in

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concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical.

See MPEP § 2144.05 (II). The court in In re Aller held, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955). The court in In re Hoeschele also held, "the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages". See 406 F.2d 1403, 160 U.S.P.Q. 809 (C.C.P.A. 1969).

Mathur teaches that ginseng extract is highly valued and expensive due to slow and laborious cultivation process and high demand in the market. See col. 1, line 21 – col. 2, line 23.

In this case, examiner takes the position that the claimed composition comprising up to 3.5 % of the amount of the antioxidants is viewed prima facie obvious over the prior art composition comprising 6 % of the recited components. examiner takes the position that the artisan would have optimized the workable weight range of the ginseng extract in order to make a cheaper and yet effective product because Chen teaches that ginseng extract is obtained by extensive extraction process, which would be costly, that high concentration of essential vitamins are found in ginseng, and Mathur teaches that the ginseng extraction method is expensive due to slow cultivation process and high demand in the market.

Regarding the applicants' claim of synergistic effect of the presently claimed invention, examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the prior art teaches the compositions that comprise same active antioxidants as presently claimed in greater weight amount. Examiner views that it would have been obvious to the skilled artisan that the synergistic antioxidant effect as claimed is obviously present in both the prior art compositions and the compositions comprising the same ingredients with lesser amount as presently claimed, absent evidence to the contrary.

**Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen and Mathur as applied to claims 1, 5, and 6 above, and further in view of Gubernick (US 6066327).**

Chen is discussed above. The reference teaches the motivation to make multi-vitamin skin care composition from natural sources. See col. 2, lines 4-42. While the reference illustrates formulas comprising ascorbic acid and generally teaches to combine vitamin C with the prior art invention, the reference fails to teach the specific vitamin C salt as recited in the present claims. The reference teaches to use ascorbic acid with ginseng extract in the composition as shown in Examples 9, 13, and 22. Example 9 discloses a composition comprising 5 % of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 13, 20, and 26.

Gubernick discloses an antioxidant mixture for cosmetic composition, which comprises magnesium ascorbyl phosphate, and rosemary extract. See Example; col. 3, lines 39 – 40. The reference teaches using ascorbic acid or the derivative thereof, which indicates the art-recognized equivalency of the components. See col. 3, lines 41 – 50; Example. Magnesium ascorbyl phosphate is taught as the particularly preferred form of vitamin C. See Id.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Chen by substituting magnesium ascorbyl phosphate for ascorbic acid as motivated by Gubernick because 1) both references are analogous as they teach multi-vitamin and antioxidant cosmetic compositions; 2) Gubernick teaches the equivalency of ascorbic acid and magnesium ascorbyl phosphate and the preference for the latter; 3) and thus the skilled artisan would have had a reasonable expectation of successfully producing a skin care composition with enhanced or similar antioxidant property and multi-vitamin effects.

**Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, Mathur, and Gubernick as applied to claims 1, 2, and 5-7 above, and further in view of Maybeck (US 5164182).**

Gubernick teaches that rosemary extract is a well-known antioxidant in cosmetic art, used in the amount of 0.0001-1 % by weight. See col. 4, lines 1-20. See instant claims 8-10 (d). The reference also teaches using 0.01-20 % by weight of magnesium ascorbyl phosphate. See col. 3, lines 41 – 50; Example. See instant claims 8(c) -10(c). In Chen, morus alba is used by 1 % by weight.

While it is viewed obvious to the skilled artisan to reduce the amount of the ingredient for cost-efficiency, the claimed invention requires 0.0005 –0.01 % of morus alba.

Maybeck teaches using mulberry extract as a skin-lightening and anti-inflammatory agent. See instant claim 7. The reference teaches using dry mulberry extract in the amount ranging from 0.005 -1 wt %, most preferably 0.005-0.1 wt %. See col. 4, line 16. See instant claims 8 (b) -10 (b).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Chen composition by adding mulberry extract in low amount as motivated by Maybeck because of the expectation of successfully producing an anti-aging cosmetic composition with skin lightening and anti-inflammatory effects in low amount.

#### ***Oath/Declaration***

The declaration filed on December 20, 2004 was fully considered but is not persuasive to overcome the prima facie case of obviousness case of the present case. The declaration indicates that antioxidants produce “synergistic, protected effects” when used in combination; the antioxidant complex is more effective than tocopherol; a moisturizer comprising 1 % of the antioxidant complex produces reduction in lipid peroxidation caused by UV radiation; a skin care composition comprising 1 % of the antioxidant complex reduces skin aging. See Results. The declaration concludes that specific combinations of the antioxidants that are recited in the claims inhibit lipid peroxidation.

Examiner takes the position that one of ordinary skill in the art would have found the results obvious in view of the cited prior arts in this case. Chen already teaches using a mixture of the antioxidants claimed by applicants. The issue in this case is thus whether it would have been obvious to the skilled artisan to use the antioxidant mixture in a lower amount, as applicants have done. The declarant states on p. 4 of the declaration, "it is well known that the properties of anti-oxidants change when the amounts of anti-oxidants change; for example they may change into pro-oxidants which cause oxidation, the effect we are trying to reduce". This statement is not supported because there is no evidence in the record that lowering the antioxidant level would cause lipid peroxidation. In the contrary, it is taught in the prior art that the high antioxidant efficiency of ginseng is due to the high concentration of antioxidants. See Chen, col. 2, line 46 – col. 3, line 22. Thus, it follows that a composition with a lower amount of ginseng ingredient in the Chen formulation would result in a composition with a less effective antioxidant effect rather than a pro-oxidant effect. While declarant also asserts, "any synergistic anti-oxidant effect found in the Examples of Chen could not be predicted to be reproduced with lesser amounts of the same ingredients". The declarant further states, "In my opinion, this disclosure would give the person skilled in the art no reason to reduce the workable quantities of the antioxidants used in these two particular examples in the expectation that a similar antioxidant effect would be obtained." However, it is noted that the courts have held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine



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experimentation. See In re Allen. There is no teaching or suggestion in the Chen reference that would have prevented a skilled artisan from reducing the amount of the potent antioxidant to find a workable amount of the costly ingredient.

### ***Response to Arguments***

Applicant's arguments filed on December 20, 2004 have been fully considered but are moot in view of the new grounds of rejection. See also Oath/Declaration.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

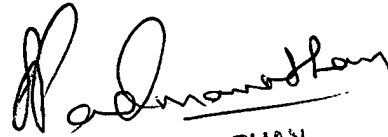
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gina Yu  
Patent Examiner



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SUPERVISORY PATENT EXAMINER